



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,678	02/04/2004	David Y. Jackson	P1778R1C2	5556
9157 7590 09/02/2008 GENENTECH, INC. 1 DNA WAY SOUTH SAN FRANCISCO, CA 94080				
EXAMINER				
DAVIS, ZINNA NORTHINGTON				
ART UNIT		PAPER NUMBER		
1625				
MAIL DATE		DELIVERY MODE		
09/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,678

Applicant(s)

JACKSON ET AL.

Examiner

Zinna Northington Davis

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 6, 9, 10, 13-19 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 14, 15, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 5, 9, 10, 13, 16, 17 and 25-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

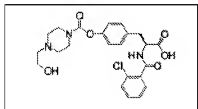
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the PETITION TO REVIVE UNDER 37 C.F.R. 1.137(b) filed November 27, 2006.
2. On November 17, 2007, the petition has been granted.
3. Claims 1, 2, 5, 6, 9, 10, 13-19, and 25-29 are pending. Claims 3, 4, 7, 8, 11, 12, and 20-24 have been cancelled.
4. In the response filed April 11, 2005, Applicants have elected the invention of Group I, claims 1, 2, 5, 9, 10, 13-19, and 25-29. The preferred species is the compound of example 023. The election is made without traverse. The species is depicted as follows:



5. Claim 6 is drawn to a non-elected invention.
6. Based upon the response filed October 27, 2006, the rejections set forth in the Office Action mailed March 27, 2006 under 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 102(b) based upon Athena Neurosciences, Inc. and McKillop et al. are withdrawn.
7. The indicated allowability of claim 15 is withdrawn.
8. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1625

remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

9. Claims 1, 2, 5, 9, 10, 13-19, and 25-29 are Markush claims which are generic to the elected invention. These Markush claims lack unity of invention. Accordingly, the Markush type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. See MPEP 803.02.

10. Claims 1, 2, 5, 9, 10, 13-19, and 25-29 are objected on the grounds that the claims are drawn to an improper Markush group. In re Hamisch, 206 USPQ 300, states that a unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. In the instant case, the claimed subject matter does not share a substantial structural feature disclosed as being essential to that utility.

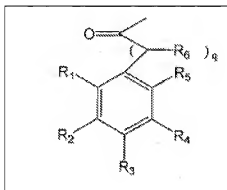
The requirement for a proper Markush claim is that it includes only substances that in their physical, chemical and physiological characteristics are functionally equivalent. The members of the instant Markush groups possess widely different, physical and chemical properties. The compounds are not considered functionally equivalent and are so diverse that they demonstrate dissimilar and unrelated properties. The mere fact that there is structural similarity in pharmaceutical agents is not in itself reason to render all the embodiments functionally equivalent.

The improper Markush groups are X₁, A, and Y.

11. The examined subject matter is as follows:

Art Unit: 1625

A compound of formula I where X_1 is $-C(O)NR_aR_b$; R_a and R_b are individually defined or R_a and R_b together with the nitrogen atom to which they are attached form a heterocyclyl or heteroaryl group; A has the structure:



and Y is OH, alkoxy, alkoxyalkoxy, aryloxy,

alkylaminoalkoxy, dialkylaminoalkoxy, alkylamino, arylamino, and heterocyclyl where each of the forgoing may be substituted or unsubstituted. The radicals not defined herein are defined according to claim 1. Amending the claims to the examined subject matter would overcome the improper Markush rejection.

12. The elected compound is allowable. However, the search has been extended beyond the elected species. The following rejections are applicable.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 1, where is the radical, B? Clarification is appreciated.

Art Unit: 1625

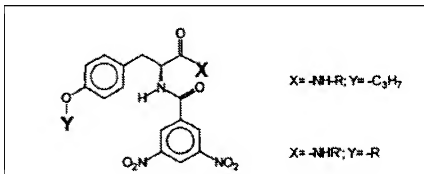
15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

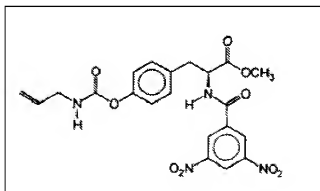
(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 2, 14, 15, 18, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Veigl et al. (Reference U, cited by the Examiner).

The instantly claimed compounds are disclosed. At page 136, Figure 1, see the generic formula. The formula is depicted below:



At page 138, see compound 3. The compound is depicted below:



17. Claims 5, 9, 10, 13, 16, 17 and 25-29 are objected to.

Art Unit: 1625

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

19. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
Art Unit 1625**